

REMARKS

Claims 1-32, 35, and 36 were previously pending in the present application. Claims 1, 4, and 12 have been amended. Claims 2, 13, and 18 have been canceled. New claims 37-39 have been added.

Claims 1 and 12 have been amended to recite that the curable composition comprises a curable binder that is curable thermally and/or with actinic radiation. Finally, claim 1 has also been amended to recite the limitations of claim 2, which is now canceled. Thus, claims 1, 3-12, 14-32, and 35-39 are pending upon entry of the above amendments.

Claims 1-32, 35, and 36 were pending in the present application, and are subject to a restriction requirement as follows:

Group I, Claims 1-11, 13-32, 35 and 36, drawn to a curable composition comprising deagglomerated barium sulfate containing at least one dispersant and at least one crystallization inhibitor.

Group II, Claim 12, drawn to a polymeric premix.

In response to the Examiner's Restriction, Applicants hereby elect prosecution of Group I, claims 1-11, 13-32, 35 and 35, drawn to the curable composition, with traverse. This election is being made without prejudice to Applicants' rights with respect to the unelected claims, including the right to file divisional applications thereon.

It is the PTO's position that restriction is required between the inventions of Group I and Group II, because the common technical feature in all the groups is deagglomerated barium sulfate containing at least one dispersant and at least one crystallization inhibitor. Restriction is said to be appropriate on the grounds that the claims lack unity of invention. In particular, the PTO states

The common technical feature in all the groups is deagglomerated barium sulfate containing at least one dispersant and at least one crystallization inhibitor. The element cannot be a special feature under PCT Rule 13.2 because the element in shown in the prior art. Ruddy (US 5,593,657) teaches a composition of matter comprising nanoparticles of a barium sulfate having associated with the surface thereof a combination of a non-ionic and anionic stabilizer.

(Office Action of September 29, 2010, page 3.)

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree, in traversing the restriction requirement resulting in a provisional election of Group I.

First, the corresponding special technical feature common to independent claims 1 and 12 is not merely deagglomerated barium sulfate with crystallization inhibitor and dispersant, alone. Rather, the technical feature common to the curable composition of claim 1 and the polymeric premix of claim 12 is the combination, as a whole, of the recited components in a "curable composition." To clarify this point, claims 1 and 12 have been amended to recite that the curable composition comprises a curable binder that is curable thermally and/or with actinic radiation.

Ruddy (U.S. Patent No. 5,593,657) is not directed to a curable composition. Instead, Ruddy is directed to x-ray contrast compositions for oral or retrograde examination of the gastrointestinal tract comprising nanoparticles of a barium salt having associated with its surface non-ionic and anionic stabilizers. While polymers are disclosed by Ruddy, they are not curable polymers, by which is ordinarily meant compositions in which a polymeric binder cures or crosslinks "thermally and/or with actinic radiation." (Page 16, lines 11-18, of the present application.)

Claim 12, Group II, also contains a curable polymer binder, as indicated on page 13, line 22, to page 9, line 9, of the application as originally filed.

It is respectfully submitted that the use of this combination of claimed components in a curable composition is a 'special technical feature' as that term is defined in MPEP 1893.03(d), i.e., meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

In view of the above, it is respectfully submitted that unity of invention does exist. Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

Per the requirements of 37 CFR 1.499 and 37 CFR 1.43, however, Applicants hereby have elected the invention of Group I with traverse. If the restriction requirement is maintained, Applicants hereby authorize the cancellation of claims 12 as being drawn to a non-elected invention.

The Office Action also requires Applicants to elect a single specific species for each of (i) a dispersant, and (ii) a crystallization inhibitor. Applicants hereby elect, as a species of the

dispersant (i), a terminally-substituted polyetherpolycarboxlate (Melperse®0030). See page 10, lines 10-12, and page 30, line 19, of the application as filed. Applicants hereby elect, as a species of the crystallization inhibitor (ii), citric acid. See page 6, lines 1-2, and page 30, line of the application as filed.

The following claims read on the elected species: Claims 1, 2, 4, 5, 7, 8, 9, 10, 11, 13-32, 35, and 36.

New Claims

New Claim 37 is supported by original claim 4. New claim 38 is supported by the application on page on page 5, line 32. New claim 39 contains all the limitations of amended claim 1 and also incorporates limitations from dependent claims 4, 8, and 17.

If the Examiner has any questions as to this response, the undersigned is available for a telephone conference at the number below.

Respectfully Submitted,

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